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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,838	01/21/2000	BERTRAND VERDAGUER	TSRI504.1	3464

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EXAMINER

ZHOU, SHUBO

ART UNIT PAPER NUMBER

1631

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/202,838

**Applicant(s)**

VERDAGUER ET AL.

**Examiner**

Shubo (Joe) Zhou

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) 19,20 and 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 is/are allowed.
- 6) ☒ Claim(s) 1,3-9,16,17,21 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 2,7 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/1/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicants' amendment and request for reconsideration in the communication filed on 9/20/04 is acknowledged and the amendments entered.
2. Applicant's arguments in response to the previous Office action have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous Office actions are hereby withdrawn. The following rejections and/or objections are reiterated from the previous Office action, mailed 11/19/03, and constitute the complete set presently being applied to the instant application.
3. The rejection of claims 23 and 24 under 35 USC 101 as being drawn to non-statutory subject matter in the previous Office action mailed 11/19/03 is hereby withdrawn in view of the amendments to the claimed filed 9/20/04.
4. The rejection of claim 2 under 35 U.S.C. § 102(b) as being anticipated by Calvert et al. (IDS document: J Gen Virol. May 1995, Vol. 76, pages: 1271-8) in the previous Office action mailed 11/19/03 is hereby withdrawn because the reference does not teach a sequence comprising the entire sequence of SEQ ID NO:3.

### ***Claim Rejections-35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1, 3-9, and newly added claims 16-17, 21 and 23-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Calvert et al. (IDS document: J Gen Virol. May 1995, Vol. 76, pages: 1271-8).

The claims are drawn to an isolated nucleic acid comprising a promoter sequence that is 95% identical to 18 sequential nucleotides of SEQ ID NO:3, or vectors comprising the nucleic acid.

Calvert et al. disclose an isolated nucleic acid molecule (a vector molecule) comprising a sequence that is 98.2% identical to the entire sequence of SEQ ID NO:3.

It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

In the instant case, Calvert et al. disclose an isolated nucleic acid molecule comprising a sequence of CsVMV virus that has a 98.2% overall identity to the sequence of the instant SEQ ID NO:3. There is reason to believe that the nucleic acid comprises a promoter sequence that is capable of initiating transcription of an operably linked heterologous nucleic acid sequence in a plant cell wherein said nucleotide sequence has at least 95% identity to 18 sequential nucleotides of the instant SEQ ID NO:3; that the plant cell can be a dicot or a monocot; and that the transcription can be initiated in a plant mesophyll tissue, phloem tissue, or root tip tissue.

The above statement is evidenced by Berdaguer et al. (IDS document: Plant Molecular Biology, 1996, Vol. 31, pages 1129-39) who disclose exactly such (page 1129, Abstract, pages 1132-1135, especially Figures 6-7).

This rejection is reiterated from the previous Office action and maintained for reasons of record.

Applicant's arguments filed 9/20/04 have been fully considered but they are not persuasive.

Applicants argue that in light of the specification, the term "isolated nucleic acid" is meant only the separated promoter sequence which does not contain any adjacent naturally occurring genomic sequence. Accordingly, since the cited reference teaches the genomic sequence of CVMV, not the separated promoter sequence, the rejection is improper. This is not found persuasive because the language "comprising" contained in the claims allows for the presence of sequence other than the promoter sequence. The claims thus read on the entire sequence of CVMV. Further, the isolated nucleic acids in such claims as 2 and 18 comprise the entire sequence of SEQ ID NO:3, which comprises sequence other than the promoter.

### ***Claim Objections***

7. Claims 2, 7, and 21 are objected to because they contain subject matter drawn to unelected inventions. The sequence of SEQ ID NO:3 (pA) has been elected by applicants, but sequences other than SEQ ID NO:3 are present in the claims.

This objection is reiterated from the previous Office action and maintained for reasons of record. Applicants argue that the non-elected sequences are species of the elected SEQ ID NO:3. This is not found persuasive because the sequence election requirement made in the Office action mailed 6/27/01 is not a species election requirement.

8. Claims 2, 7, and 21 are objected to also because each of them depends from a rejected claim: claims 2 and 7 from claim 1, and claim 21 from claim 16.

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9. Appropriate corrections are required.

***Conclusion***

10. Claim 18 is allowed.

11. **THIS ACTION IS MADE FINAL.**

12. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136

(a). A shortened statutory period for response to this final action is set to expire three months from the date of this action. In the event a first response is filed within two months of the mailing date of this final action and the advisory action is not mailed until after the end of the three-month shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136 (a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than six months from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shubo (Joe) Zhou, whose telephone number is 571-272-0724. The examiner can normally be reached Monday-Friday from 8 A.M. to 4 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on 571-272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst Tina Plunkett whose phone number is (571) 272-0549.

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14. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

JOHN S. BRUSCA, PH.D  
PRIMARY EXAMINER

Shubo (Joe) Zhou, Ph.D.



Patent Examiner

*John S. Brusca 1 December 2004*